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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,714	11/21/2003	Massimo Scagliarini	2502-1042	8852

466 7590 02/28/2006

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,714	SCAGLIARINI ET AL.	
	Examiner	Art Unit	
	Krishnan S. Menon	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-23 are pending as originally filed

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2,17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites "... these latter together", which is unclear. For examination, "these latter" is assumed as the membranes (44).

Claim 17: "... but not provided with these latter" is not understood. This part is ignored for examination purpose.

Claim 18: "this later" is not properly understood. Surfaces (5A) and (5B) and channels (21) are assumed to have the same shape from this language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1,2,5-8 and 10-18 rejected under 35 U.S.C. 102(a/e) as being anticipated by EP 1 208 857 A1.

Claim 1: EP'857 teaches an infusion filter (see figures) with case (2), cavity (32), inlet and outlet (12,13), plurality of channels (23 and 24), hydrophilic membrane (26 and 27), spaced apart apertures (33) covered by hydrophilic membranes (34), the hydrophobic membranes are bound by a solid line surrounding it (like a line around 7 in figure 1) and the hydrophilic membrane would be substantially contained within it. The filter in the reference is enabled to be employed at different special positions.

Claim 2: this only describes an imaginary line drawn around the windows 33.

Claims 5-8, 10: aperture sized identical to or less than that of the size of the membrane: figure 4 shows the membrane 44 in a recess of same size as the membrane and the aperture 33 as smaller than the membrane. Since the recess forms part of the aperture, the claims are met. Shape shown is rectangular, which is a polygon.

Claim 11: hydrophobic membrane fixed to face the hydrophilic membrane – figure 4.

Claims 12-18: channels, entry conduits, stems, etc., of the claim similar in structure to that of the reference. See figures.

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2. Claims 1 and 5-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Stankowski et al (US 5,439,587).

Stankowski teaches an infusion line filter having a box cover (56), inlet and outlet (11,13), an inner surface with plurality of channels, annular rims and ridges (36,38,50-53), hydrophilic membrane (30,32), vent holes (18 and 22) in recessed apertures on the cover 56, with hydrophobic membranes (20,24) as claimed. Imaginary line (70) can be drawn around the box 56 to include all the vent holes and the hydrophilic membrane as claimed. It can be used in plurality of positions as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3,4,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stankowski.

Stankowski differs from the claims in the recitation of the dimensions spacing of the filter membranes from the box casing or the shape of the recess. Relative sizes and shapes are not patentable unless it can be shown that such sizes or dimensions make an unobvious difference to the structure. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and

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the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

4. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stankowski (or EP'857) as applied to claim 1 above, and further in view of Ruschke (US 4,190,426).

Claims 21-23 differ from the teaching of Stankowski (or EP'857) in the recitation of the shut-off members. Ruschke teaches a shut of member (umbrella valve – 46 in figures and column 7 line 57 – column 8 line 36). The umbrella valve is completely removable by prizing out. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Ruschke in the teaching of Stankowski (or EP'857) to have protection against entry of ambient air in to the filter while venting the gases from inside as taught by Ruschke (see abstract)

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K S Menon', with a stylized, cursive script.

Krishnan S. Menon
Patent Examiner
2/23/06